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09/812,472	03/19/2001	Lenka M. Jelinek	5038-67	1643

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GREGORY D. CALDWELL  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
12400 WILSHIRE BOULEVARD  
7TH FLOOR  
LOS ANGELES, CA 90025

EXAMINER

SAADAT, CAMERON

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/812,472

Applicant(s)

JELINEK, LENKA M.

Examiner

Cameron Saadat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

In response to amendment filed 6/23/2004, claims 1-32 are pending in this application.

#### *Claim Objections*

Claims 22-23 are objected to because the dependency of claim 22 upon itself is improper and appears to be a typographical error.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-3, 5-8, 13-18, 20-21, 23-25, 27, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Satoh (GB 2 227 183 A).**

Regarding claims 1 and 5, Shackelford discloses a toy set comprising: a play set having a theme of character health and happiness in a home environment; a panel having a first surface, the first surface adapted to simulate a wall to use with a toy figurine related to the theme; and a first display 93 that is to be attached to the first surface (Col. 11, lines 37-39; See Fig. 5), the first display adapted to receive a first set of background image data related to the theme of character health and happiness, and to display a first

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image responsive to the first set of image data, wherein the image data is distinct from the wall simulated on the first surface of the panel (Col. 14, lines 17-30).

Regarding claim 25, Shackelford discloses an article comprising: a storage medium 90 comprising instructions such that, when executed by at least one device, result in: waiting to receive a signal output from a detector indicative of a toy figurine characteristic; the toy figurine having a theme related to character health and happiness; and if the signal is received, transmitting a first set of image data to a display associated with a panel to cause the display to display an image corresponding to a first set of image data related to the theme of character health and happiness, wherein the panel is adapted to provide a first surface which simulates a wall to use with the toy figurine and the image data is distinct from the wall simulated on the first surface of the panel (Col. 14, lines 17-52; Col. 11, lines 37-39).

Regarding claim 29, Shackelford discloses a method comprising: providing a play set having a theme of character health and happiness; providing a panel having a first surface which simulates a wall to use with a toy figurine related to the theme; waiting to receive an output of a detector about a location of the toy figurine; and if the output is received, transmitting a first set of image data to a display associated with the panel to cause the display to display an image corresponding to the first set of image data related to the theme of character health and happiness, wherein the image data is distinct from the wall simulated on the first surface of the panel (Col. 14, lines 17-52; Col. 11, lines 37-39).

Regarding claims 1, 5, 25, and 29 the play set described in Shackelford provides an interactive environment between toy figurines and display 93, wherein character health and happiness information is displayed in response to figurine actions in the play environment. Shackelford does not explicitly disclose the feature of displaying *background scene* image data. However, Satoh teaches a toy set having a theme, comprising: toy figurines 106A-B; display 186 attached to a simulated wall; wherein *background scene* images 188 are displayed (See Fig. 19; P. 23 lines 10-15). Hence, in view of Satoh, it would have been obvious to artisan to modify the theme and displayed images of the play set described in

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Shackelford, by *providing background scene* image data in order to provide interaction between a figurine and a display, wherein the figurine appears to communicate with displayed character 194 in the background scene image, thereby creating an atmosphere and theme related to a stage and characters in a staged play set (Col. 19, lines 17-23). In addition, with regard to claim 5, Shackelford does not explicitly disclose that the image data is from a video camera. However, Satoh teaches a play set comprising a display 186, wherein displayed images are derived from a video camera (P. 15, lines 2-17). Hence, in view of Satoh, it would have been obvious to one of ordinary skill in the art to modify the source of imaged data for Shackelford's display, by providing images derived from a video camera in order to provide background scenery image data that provides an atmosphere where figurines appear to communicate with the displayed background images.

Regarding claim 2, Shackelford discloses a toy set, wherein the panel has a data connection allowing the display 93 to receive image data from controller 90 (See Fig. 5, Fig. 14).

Regarding claim 3, Shackelford discloses a toy set, wherein a display is attached to a panel (Col. 11, lines 37-39). It is not explicitly disclosed that the display is attached to the panel with Velcro™. However, it would have been an obvious matter of design choice as to the method of attaching a display to a panel, wherein no stated problem is solved or unexpected result is obtained by prescribing a Velcro™ attachment.

Regarding claims 6, 27, and 31 Shackelford discloses a toy set, wherein the first set of image data is one of a plurality of sets stored in a memory (See Col. 14, lines 17-19).

Regarding claim 7, Shackelford discloses a toy set, further comprising: a toy figurine having a theme related to a theme of the first image (See Col. 14, lines 17-19).

Regarding claim 8, Shackelford discloses a toy set, further comprising a stand-alone controller 90 to transmit the first set of image data to the first display 93.

Regarding claim 13, Shackelford discloses a toy set, comprising a display attached to a simulated wall, wherein the display is a liquid crystal display. It is not explicitly stated that the display includes light emitting diodes. However, it would have been an obvious matter of design choice as to choosing a specific type of display for displaying images, wherein no stated problem is solved or unexpected result is obtained by prescribing a light emitting diode display.

Regarding claim 14, Shackelford discloses a toy set, wherein the display includes a screen (See Fig. 14, ref. 93).

Regarding claim 15, Shackelford discloses a toy set, wherein the screen is a liquid crystal display screen (See Fig. 14, ref. 93).

Regarding claim 16, Shackelford discloses a toy set, further comprising: a light source 39, 44, 50 (See Col. 10, lines 38-43).

Regarding claim 17, Shackelford discloses a toy set, further comprising: a speaker (See Fig. 5, ref. 92).

Regarding claim 18, Shackelford discloses a toy set, further comprising: a detector to detect a condition of the environment in which the play set is disposed, wherein the first set of image data is responsive to an output of the detector (Col. 14, lines 37-52).

Regarding claim 20, Shackelford discloses a toy set, further comprising: a lamp 39, 44, 50, wherein the lamp is controlled responsive to an output of the detector (See Col. 10, lines 37-46).

Regarding claim 21, Shackelford discloses a toy set, wherein the detector is to detect one of a location or an identity of the toy figurine (See Col. 14, lines 37-52).

Regarding claim 24, Shackelford discloses a toy set, comprising a display attached to a simulated wall, wherein the display presents multiple images in association with a toy figurine. It is not explicitly disclosed that the toy set comprises a second display. However, it would have been an obvious to an artisan to modify the toy set described in Shackelford, by providing additional components, such as add-

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on modules (Col. 25, lines 31-36; Col. 26, lines 22-40) described in Shackelford, or any other component, in order to expand the toy set environment.

**Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Satoh (GB 2 227 183 A), further in view of Shackelford (USPN 6,443,796 B1).**

Regarding claim 4, Shackelford ('931) discloses a toy set, wherein display 93 is attached to a panel (Col. 11, lines 37-39), and wherein the panels comprise mating openings SP1-7 for electronically mounting add-on modules (Col. 22, lines 1-5; Col. 10, lines 57-67), wherein the add-on module is a device that is electronically dependent on controller 90 (See Col. 21, lines 56-59). Shackelford ('931) further discloses a panel having protrusions 73 and 74 for mating with toy pieces having protrusions 68 and 69. The combination of Shackelford ('931) and Satoh does not explicitly disclose a display attached to the panel by placing a protrusion in a mating opening. However, Shackelford ('796) teaches a toy set wherein display 53 is attached to panel 15 by placing a mating opening of the display in the protrusion of the panel (Col. 13, lines 55-65). Hence, in view of Shackelford ('796) it would have been obvious to modify the display described in Shackelford ('931) by providing mating openings in the display piece such that it can be attached to protrusions in a panel in order to provide a toy set that allows a child to place play pieces at certain locations in a construction set while providing an electrical connection to the play pieces in order to provide interactive responses.

Regarding claim 9, Shackelford ('931) discloses a toy set, wherein the stand-alone controller is adapted to receive inputs from controllers of add-on modules (Col. 25, lines 31-36; Col. 26, lines 22-40). It is not explicitly stated that controller 90 is adapted to receive inputs from a *personal computer*. However, Shackelford ('796) teaches a toy set comprising controller 17, which is adapted to receive inputs from personal computer 66 (See Fig. 2). Hence, in view of Shackelford ('796), it would have been obvious to an artisan to modify the controller described in Shackelford ('931) by adapting the controller

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to receive inputs from a personal computer in order to provide distribution of new game programs and other updates to the controller of the toy set such that the toy set never stales (See Shackelford '796, col. 8, lines 53-64).

**Claims 10-11, 26, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Satoh (GB 2 227 183 A), further in view of Gabai et al. (USPN 6,352,478 B1; hereinafter Gabai).**

Regarding claims 10, 26, and 30 Shackelford discloses a toy set comprising display 93, which is electrically connected to controller 90 for receiving image data. Shackelford further discloses various stand-alone structures, wherein controller 90 comprises a transmitting antenna to transmit data to the stand-alone structures to form an expanded environment. (See Fig. 19). The combination of Shackelford and Satoh does not explicitly disclose that the transmitting antenna transmits image data to a receiving antenna of the display. However, Gabai teaches a toy set wherein transmitter 1504 transmits image data to a receiving antenna 1514 coupled to a display (See Fig23). Hence, in view of Gabai, it would have been obvious to one of ordinary skill in the art to modify the method of distributing image data as described in Shackelford, by transmitting and receiving the image data via antenna, in order to provide a wireless link between toy set components and thereby form an expanded environment.

Regarding claim 11, the combination of Shackelford, Satoh, and Gabai discloses all of the claimed subject matter with the exception of explicitly disclosing that the receiving antenna of the display is *within a panel*. However, it would have been an obvious matter of design choice as to the placement of the receiving antenna of the display, wherein no stated problem is solved or unexpected result is obtained by prescribing a location within the panel.

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Satoh (GB 2 227 183 A), further in view of Comiskey et al. (U.S. Patent No. 6,459,418; hereinafter Comiskey).**



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Shackelford and Satoh disclose a toy set, comprising a display attached to a simulated wall, wherein the display presents images in association with a toy figurine. It is not specified that the images are displayed using *electronic printed ink*. However, Comiskey teaches a display that is powered and controlled using radio frequencies, wherein images are displayed using electronic printed ink (Column 5, lines 35-40), and wherein the display system is meant to be used anywhere it is useful to provided intermittent updates of information (See Abstract). In view of Comiskey, it would have been obvious to a person of ordinary skill in the art to modify the display system described in Shackelford and Satoh, by displaying images using an electronic ink display, thereby providing a highly-flexible display that can be manufactured easily, consuming little power, which can be incorporated into a variety of applications (see Comiskey, column 2, lines 16-23).

**Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Satoh (GB 2 227 183 A), further in view of Lee et al. (U.S. Patent No. 6,102,397; herein after Lee).**

Regarding claim 19, Shackelford disclose a toy set, comprising a detector to sense the location of a toy figurine, and to display image data on display 93 based on the detection of a toy figure position (Col. 14, lines 17-52). The combination of Shackelford and Satoh does not specifically disclose a detector that is a light sensor. However, Lee teaches a toy set, wherein optical detectors are utilized to determine identification of game pieces (column 4, lines 61-65). Hence, in view of Lee, it would have been obvious to a person of ordinary skill in the art to modify the sensing means described in Shackelford and Satoh, by providing optical sensors, in order to determine the position of a toy figurine and to further differentiate between each figurine, thereby producing an appropriate audio or visual response to the figurine position.

**Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Satoh (GB 2 227 183 A), further in view of Baxter (GB 2 271 724 A).**

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Regarding claim 22, Shackelford disclose a toy set, comprising a detector to sense the location of a toy figurine, and to display image data on display 93 based on the detection of a toy figure position (Col. 14, lines 17-52). The combination of Shackelford and Satoh does not specifically disclose a detector that is a *pressure sensor* associated with a bottom panel to sense a weight of the toy figurine. However, Baxter teaches a toy set, wherein pressure sensors are used to detect the weight of a toy figurine and to further differentiate between each figurine (see Abstract). It would have been obvious to an artisan to modify the sensing means described in Shackelford and Satoh, by providing pressure sensors, in light of the teachings of Baxter, in order to determine the position of a toy figurine and to further differentiate between each figurine, thereby producing an appropriate audio or visual response to the figurine position.

**Claims 23, 28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford (USPN 6,227,931 B1) in view of Satoh (GB 2 227 183 A), further in view of Gilboa (U.S. Patent No. 5,853,327).**

Regarding claims 23, 28, and 32 Shackelford disclose a toy set, comprising a detector to sense the location of a toy figurine, and to display image data on display 93 based on the detection of a toy figure position (Col. 14, lines 17-52). Shackelford further discloses controller 90, adapted to transmit and receive RF signals with multiple stand-alone character environments (Col. 26, lines 35-40). It is not explicitly stated in that the toy figurines include a transponder. However, Gilboa teaches a toy set, wherein toy figurines include a transponder, and a detector that includes an antenna to detect a return signal from the transponder (column 3, lines 37-42; column 4, lines 15-29). Hence, it would have been obvious to an artisan to modify the detection mechanism described in Shackelford and Satoh, by providing transponders within toy figurines, in order to sense the position of toy figurines without requiring line of sight, and to provide audio-visual interaction based on toy figurine position in a toy set environment.

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*Response to Arguments*

Applicant's arguments filed 6/23/2004 have been fully considered but they are not persuasive.

Applicant emphasizes the feature of providing a detector to *detect a condition of the environment in which the play set is disposed*, wherein the background scene image data is responsive to an output of the detector. Applicant asserts that the examiner acknowledged that Shackelford does not disclose this feature. However, Shackelford discloses this feature as claimed (See Col. 14, lines 37-52). The examiner did not make the acknowledgement purported by applicant. Instead, the examiner indicated that Shackelford does not teach the feature of providing a detector to *detect a temperature in the environment of the play set*, wherein the background scene image data is responsive to an output of the detector

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 9:00 - 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 703-308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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CS

  
XUAN M. THAI  
PRIMARY EXAMINER  
TC3700